

1642

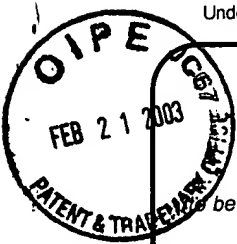
PTO/SB/21 (08-00)

Please type a plus sign (+) inside this box → ☐

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

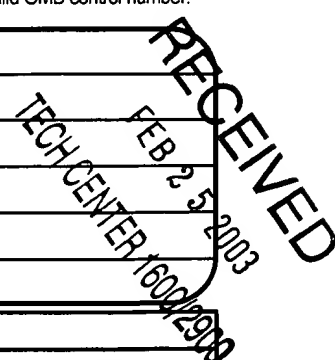


TRANSMITTAL FORM

to be used for all correspondence after initial filing)

Application Number	09/847,046
Filing Date	April 30, 2001
First Named Inventor	Hevezi, et al.
Group Art Unit	1642
Examiner Name	Davis, Minh Tam
Attorney Docket Number	018501-008210US

Total Number of Pages in This Submission 6



ENCLOSURES (check all that apply)

- | | | |
|---|---|---|
| <input type="checkbox"/> Fee Transmittal Form
<input type="checkbox"/> Fee Attached
<input checked="" type="checkbox"/> Amendment / Reply
<input type="checkbox"/> After Final
<input type="checkbox"/> Affidavits/declaration(s)

<input type="checkbox"/> Extension of Time Request

<input type="checkbox"/> Express Abandonment Request

<input type="checkbox"/> Information Disclosure Statement

<input type="checkbox"/> Certified Copy of Priority Document(s)

<input type="checkbox"/> Response to Missing Parts/ Incomplete Application
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers (for an Application)
<input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application

<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address

<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Request for Refund
<input type="checkbox"/> CD, Number of CD(s) | <input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Proprietary Information

<input type="checkbox"/> Status Letter

<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Response to Restriction (2pp); Return Postcard |
|---|---|---|

Remarks

The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm and Individual name	Townsend and Townsend and Crew LLP Kevin Bastian	Reg. No. 34,774
Signature		
Date	February 14, 2003	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Box Amendment, Commissioner for Patents, Washington, D.C. 20231 on this date: February 14, 2003

Typed or printed name	Stephanie J. Whitehurst	Date	February 14, 2003
Signature			

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

SF 1433011 v1



Region/#D
3-3-03

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

PATENT
Attorney Docket No.: 018501-008210US
Client Ref. No.: PRCA 003-14US

Box Non-Fee Amendment, Assistant Commissioner for Patents
Washington, D.C. 20231
On February 14, 2003

TOWNSEND and TOWNSEND and CREW LLP

By: _____

Stephanie J. Whitehurst

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
FEB 25 2003
TECH CENTER 1600/2900

In re application of:

Hevezi, et al.

Application No.: 09/847,046

Filed: April 30, 2001

For: NOVEL METHODS OF
DIAGNOSIS OF PROSTATE CANCER
AND/OR BREAST CANCER,
COMPOSITIONS, AND METHODS OF
SCREENING FOR PROSTATE
CANCER AND/OR BREAST CANCER
MODULATORS

Examiner: Davis, Minh Tam

Art Unit: 1642

RESPONSE TO RESTRICTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed January 14, 2003, Applicants elect with traverse to prosecute the claims of Group II directed to methods of diagnosing prostate cancer by determining the mRNA expression of a gene encoding PAA3. According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. See, the MPEP at 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching


Hevezi, et al.
Application No.: 09/847,046
Page 2

PATENT

difficulties, the Examiner must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP at § 808.02). Applicants respectfully submit that both inventions in the present application can readily be searched without undue burden.

In light of the above, Applicants respectfully request that the restriction be withdrawn. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 576-0200.

Respectfully submitted,



Kevin Bastian
Reg. No. 34,774

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: (415) 576-0300
KLB:klb
SF 1432993 v1